

Remarks

The present application was filed on February 5, 2004. This Amendment is responsive to the Office Action mailed September 29, 2004 which provided a rejection of claims 1-20. In response, the Applicant has responded to the erroneous rejection. These remarks are proper, do not introduce new matter, do not require additional searching, are not narrowing in view of a prior art rejection, and obviate the rejection so as to place the application in proper condition for allowance of all pending claims.

Rejection Under 35 USC 102(b)

Claim 14 was rejected as being anticipated by U.S. Patent No. 4,853,993 issued to Walpin ("Walpin '993"). This rejection is respectfully traversed.

Claim 14

The Examiner has failed to substantiate a Section 102 rejection because Walpin '993 does not disclose the recited feature "*means for constraining....*"

Claim 14 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified a function associated with the recited "means" element as being constraining the upper body with a supporting engagement that continuously molds and adjusts to the body shape maintaining complete contiguous contacting engagement with the body (see, for example, pg. 7 lines 23-27). The Examiner is obliged as a matter of law to construe this means element as the disclosed structure, and equivalents thereof, that are capable of the identical function. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en*

banc); In re Dossel, 42 USPQ2d 1881 (Fed. Cir. 1997); Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6, 65 FR 38510.
Failure to do so constitutes reversible error.

The present rejection is based on the Examiner's construction of the "means for constraining" as reading on Walpin '993's nodulated pad 30. (Office Action pg. 2) However, the nodulated pad 30 is the preferred embodiment for providing the convoluted contacting surface of Walpin '993: "The uppermost surface 25 of the top substructure 21 has a convoluted texture." (Walpin '993 col. 5, lines 42-43, emphasis added) Walpin's purpose for the convoluted surface is clearly explained, for example, as "allowing the users [sic] back to gain the benefits of alternating external skin pressures and air circulation." (Walpin '993 col. 2, lines 46-48). Clearly Walpin '993 only discloses structure that is inherently incapable of performing the contacting-engagement function contemplated by the embodiments of the present invention as claimed in claim 14.

The Examiner's construction of this means-plus-function claim is furthermore erroneous in that it completely ignores the explicit meaning ascribed thereto: "It will be noted the means for constraining explicitly does not contemplate the use of non-continuous contacting materials such as, without limitation, a convoluted-surface material generally known as "egg crate" type material." (specification, pg. 7, line 27 to pg. 8, line 1, emphasis added).

When this means element is properly construed, it is clear that Walpin '993, taken as a whole, fails to disclose this element. Accordingly, this rejection of claim 14 under Section 102 is erroneous as a matter of law and the Applicant requests reconsideration and withdrawal of the rejection of claim 14 and the claims depending therefrom.

Rejection Under 35 USC 102(e)

Claims 14, 15 and 19 was rejected as being anticipated by U.S. Patent No. 6,601,253 issued to Tarquinio ("Tarquinio '253"). This rejection is respectfully traversed.

Claim 14

The Examiner has failed to substantiate a Section 102 rejection because Tarquinio '253 does not disclose the recited feature "*means for constraining....*"

Claim 14 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified a function associated with the recited "means" element as being constraining the upper body with a supporting engagement that keeps the body in a partially reclined upright position (see specification, for example, pg. 1, lines 10-11; pg. 1, lines 19-20; pg. 2 lines 3-4; pg. 2 lines 14-18; pg. 5, line 18; pg. 6, lines 15-16; pg. 8, lines 11-16). The Examiner is obliged as a matter of law to construe this means element as the disclosed structure, and equivalents thereof, that are capable of the identical function. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994) (*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. Failure to do so constitutes reversible error.

The present rejection is based on the Examiner's construction of the "*means for constraining*" as reading on Tarquinio '253's top layer 20. (Office Action pg. 2) However, the top layer 20 is part of a mattress 18 that is wholly silent regarding structure for supporting the user in an upright, reclined position. Particularly, Tarquinio '253 contemplates a mattress

for supporting a user in a horizontal position in that the elongate support members stiffen the sides for added support such as when the user sits on the side of the mattress or when the user rolls over toward the side of the mattress 18. (see, for example, Tarquinio '253 col. 3, lines 28-31) Clearly Tarquinio '253 only discloses structure that is inherently incapable of performing the reclined supporting function contemplated by the embodiments of the present invention as claimed in claim 14.

When this means element is properly construed, it is clear that Tarquinio '253, taken as a whole, fails to disclose this element. Accordingly, this rejection of claim 14 under Section 102 is erroneous as a matter of law and the Applicant requests reconsideration and withdrawal of the rejection of claim 14 and the claims depending therefrom.

Rejection Under 35 USC 103

Claims 1, 2, 4-6, 18, and 20 were rejected as being unpatentable over Tarquinio '253. This rejection is respectfully traversed.

Claim 1

The Examiner has failed to make the requisite *prima facie* case of obviousness because the cited reference does not disclose or suggest all the features of the present invention as claimed in claim 1, which recites at least the following:

a base comprising a foam material with an impression load deflection (ILD) ratio greater than about 40....
(excerpt from claim 1, emphasis added)

The Examiner simply ignored the plain language of claim 1 in reading the base thereof onto Tarquinio '253: "Tarquinio discloses a supportive upper body constraint device, comprising a base comprising a foam material with an impression load deflection and a cover

20...." (Office Action, pg. 3) The Applicant agrees that the bottom layer 24 of Tarquinio '253 has an impression load deflection - all compressible materials do. The Applicant expressly traverses the Examiner's assertion that the bottom layer 24 of Tarquinio '253 reads on the claimed base comprising an ILD greater than about 40.

In order to sustain a *prima facie* case of obviousness a reference must disclose or suggest all of the claimed elements. Tarquinio '253 discloses the bottom layer has an ILD of about 32. (see, for example, Tarquinio '253 col. 1, lines 50-52) The claimed base has an ILD of greater than about 40. (see, for example, specification page 3, lines 6-7; page 5, lines 10-15) These ranges neither overlap, nor are they extrapolated in any way by the Examiner so as to be viewed as equivalent. Instead, the Examiner rejects on obviousness because: "since Applicant has not disclosed that the ILD ratios [sic] are critical and it would appear that the ILD ratios of Tarquinio would perform equally well...." This reasoning erroneous in that it has no basis in the law.

A skilled artisan recognizes that the material specified in Tarquinio '253 and the present invention serve different purposes. Particularly, the mattress of Tarquinio '253 has a softer ILD of about 32 for comfort whereas the firmer ILD of the present invention of greater than about 40 is for therapeutic support. There is no evidence from Tarquinio '253 that "about 32" means "about 40 or more." The Applicant expressly traverses the Examiner's assertion that an ILD of about 32 would suffice equivalently in the present invention; such an assertion is beyond the teaching of the present invention and the Applicant's experience in reducing the invention to practice. This basis for the rejection is apparently from facts within the Examiner's personal knowledge, and is otherwise unsubstantiated. In accordance with 37 CFR 1.104(d)(2), the Applicant hereby requests the Examiner provide a substantiating

affidavit explaining the basis for the assertion that the material of Tarquinio '253 meets the explicitly claimed requirements of claim 1.

Tarquinio '253 does not disclose or suggest a base member having an ILD of about 40 or more. Accordingly, Tarquinio '253 cannot sustain a prima facie case of obviousness because it does not disclose or suggest all the features of the embodiments of the present invention as claimed in claim 1. The present rejection is erroneous as a matter of law for lacking a prima facie case of obviousness. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Claims 2, 4-6, 18, and 20

These claims are allowable as dependent claims depending from an allowable independent claim, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of this rejection are respectfully requested.

Rejection Under 35 USC 103

Claims 1-3, 5-13, and 15-20 were rejected as being unpatentable over Walpin '993 in view of Tarquinio '253. This rejection is respectfully traversed.

Claim 1

The Examiner has not made a prima facie case of obviousness because the cited references do not disclose or suggest all the features of the present invention as claimed in claim 1, and because there is no reasonable expectation of success resulting from combining the references in the way the Examiner proposed. Claim 1 recites at least the following:

a base comprising a foam material with an impression load deflection (ILD) ratio greater than about 40; and a cover

comprising a foam material with an ILD ratio less than the base....

(excerpt from claim 1, emphasis added)

The Examiner first argued that it would be obvious to combine the cover of Tarquinio '253 with the structure of Walpin '993 in arriving at the presently claimed invention. The Applicant agrees with the Examiner's statement: "Walpin fails to disclose the cover having an ILD ratio less than the base." (Office Action pg. 4) The Examiner has failed to provide a *prima facie* case of obviousness, however, because there is no reasonable expectation of success resulting in combining the viscoelastic cover of Tarquinio '253 with the substructure of Walpin '993.

As discussed above, Walpin '993 discloses a convoluted surface 25 for the purpose of providing an alternating contacting engagement of skin pressure and air circulation. In other words, Walpin '993 relies on a surface that provides a non-contiguous contacting engagement with the user. Replacing the relatively firm nodulated foam 30 in Walpin '993 with the elastomeric material of Tarquinio '253 defeats the purpose of Walpin '993. A skilled artisan recognizes that elastomeric material, as the Examiner urges, is inherently incapable of providing the convoluted surface of Walpin '993. For at least this reason, the skilled artisan recognizes there is no reasonable expectation of success in the combination of references urged by the Examiner. Accordingly, the combination cannot sustain a *prima facie* case of obviousness.

The Examiner also argued that "it would have been obvious to have the ILD ratio greater than 40, since Applicant has not disclosed that ILD ratios are critical and it would appear that the ILD ratio of Walpin would perform equally well." (Office Action pg. 5) The Applicant agrees with the Examiner's statement: "Walpin also fails to disclose the ILD ratio

of the base greater than 40." (Office Action pg. 4-5) However, the Applicant expressly traverses the Examiner's assertion that the explicitly claimed feature is obvious in view of Walpin '993.

As stated above, in order to sustain a *prima facie* case of obviousness a reference must disclose or suggest all of the claimed elements. Walpin '993 is wholly silent regarding the ILD characteristics of its materials. The present invention discloses a base having an ILD of greater than about 40, and a preferred embodiment of about 44. (see, for example, specification page 3, lines 6-7; page 5, lines 10-15) As above, ranges neither overlap, nor are they extrapolated in any way by the Examiner so as to be viewed as equivalent. Instead, the Examiner rejects on obviousness because: "since Applicant has not disclosed that the ILD ratios are critical and it would appear that the ILD ratio of Walpin would perform equally well...." This rejection is erroneous in that its reasoning has no basis in the law.

In essence the Examiner has used a reference that is wholly silent regarding a claimed feature as an obvious variant for the invention because, despite the written description and explicit claim language, the Applicant has not satisfied some mythical "criticality" threshold created erroneously in the Examiner's assertion but nonexistent in the law. The reasoning is apparently based only on facts within the personal knowledge of the Examiner. In accordance with 37 CFR 1.104(d)(2), the Applicant requests the Examiner provide a substantiating affidavit explaining the basis for the assertion that the material of Walpin '993 meets the explicitly claimed requirements of claim 1.

Also, as discussed above, Tarquinio '253 does not disclose or suggest a base member having an ILD of about 40 or more. Accordingly, Walpin '993 combined with Tarquinio '253 cannot sustain a *prima facie* case of obviousness because there is no reasonable

expectation of success in combining the references as urged by the Examiner, and because they do not, alone or in combination, disclose or suggest all the features of the embodiments of the present invention as claimed in claim 1. This rejection is erroneous as a matter of law for lacking the requisite *prima facie* case of obviousness. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

Claims 2-3, and 5-6

These claims are allowable as dependent claims of an allowable independent claim, for reasons above, that provide additional limitations thereto. Reconsideration and withdrawal of the present rejection are respectfully requested.

Claim 7

The Examiner has failed to make the requisite *prima facie* case of obviousness because the cited references do not disclose or suggest all the features of the present invention as claimed in claim 1, and because there is no reasonable expectation of success resulting from combining the references in the way the Examiner proposed. Claim 1 as filed recites at least the following:

a base comprising a substantially flat longitudinal surface and an inclined surface...a pair of opposing support members on the inclined surface...and a cover...covering the support members and a portion of the inclined surface...comprising a viscoelastic foam material....
(excerpt from claim 1, emphasis added)

The Examiner read the claimed longitudinal and inclined surfaces of the base onto Walpin '993's insert 15, top substructure 21, and bottom substructure 22. These elements are

positionable into different arrangements. However, the only element of Walpin '993 comprising both a longitudinal and inclined surface is the bottom substructure 22 in the embodiments of FIGS. 3-7. Clearly, the opposing support members 26, 27 are not attached to the inclined surface of the bottom substructure, as in the embodiments of the present invention as claimed in claim 7.

The Examiner further asserts it would be obvious to modify Walpin '993 by substituting the elastomeric cover of Tarquinio '253. The Applicant agrees with the Examiner's statement: "Walpin fails to disclose a portion of the inclined surface between the support members comprising a viscoelastic foam material." (Office Action pg. 5) As discussed above, however, the Examiner has failed to provide a *prima facie* case of obviousness because there is no reasonable expectation of success resulting in combining the viscoelastic cover of Tarquinio '253 with the substructure of Walpin '993.

Recalling from above, Walpin '993 discloses a convoluted surface 25 for the purpose of providing an alternating contacting engagement of skin pressure and air circulation. In other words, Walpin '993 relies on a surface that provides a non-contiguous contacting engagement with the user. Replacing the relatively firm nodulated foam 30 in Walpin '993 with the elastomeric material of Tarquinio '253 defeats the purpose of Walpin '993. A skilled artisan recognizes that elastomeric material, as the Examiner urges, is inherently incapable of providing the convoluted surface of Walpin '993. For at least this reason, the skilled artisan recognizes there is no reasonable expectation of success in the combination of references urged by the Examiner. Accordingly, the combination cannot sustain a *prima facie* case of obviousness.

Accordingly, Walpin '993 combined with Tarquinio '253 cannot sustain a *prima facie*

case of obviousness because the references do not, alone or in combination, disclose or suggest all the claimed features and because there is no reasonable expectation of success in combining the references as urged by the Examiner. The present rejection is erroneous as a matter of law for lacking the requisite *prima facie* case of obviousness. Reconsideration and withdrawal of the present rejection of claim 7 and the claims depending therefrom are respectfully requested.

Claims 8-13, and 15-20

These claims are allowable as dependent claims depending from an allowable independent claim, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

This is a complete response to the Office Action mailed September 29, 2004 as understood by the Applicant. All of the rejections are erroneous as a matter of law, as discussed above, such that all claims are allowable as originally filed. However, the Applicant has replied only to the extent that the rejections are understood. The Applicant has submitted herewith a request for telephone interview, the time of which to be determined by the Examiner after considering this Amendment and before issuing an action on the merits. The Applicant believes the interview will be necessary, if issues preventing passage to allowance remain, to facilitate prosecution on the merits in an application where Applicants valuable patent has already been unduly delayed. The Applicant respectfully requests that the Examiner reconsider the application and allow all of the pending claims. The Examiner

is expressly requested to contact the below signed Attorney to schedule the requested
interview should any issues remain preventing all claims from passing to allowance.

Respectfully submitted,

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